

REMARKS/ARGUMENTS

[0200] Please note that conflicting statements in the Office Action dated 09162004 (“the Office Action”) require applicant to respond to several different possible meanings embodied in the Office Action. For example, the Office Action cover sheet (PTOL-326) states that “Claims 1, 3-9, 11-15 is/are rejected.” This implies that claim 12 is rejected, yet the Office Action gives no reason for the rejection of claim 12. Applicant finds it impossible to argue against rejection where no reasons for rejection are given.

[0201] The Office Action cover sheet (PTOL-326) states that “Claims 1, 3-9, 11-15 is/are rejected.” This implies that claims 16-19, previously submitted are not rejected. The Detailed Action section of the Office Action does not explicitly reject claims 16-19. The claims are discussed, but the language preceding the discussion simply states, for example, “Regarding claims 1, 8-9, 16, 18....” Applicant is unclear as to the meaning of such wording. There are several instances where claims are clearly rejected using language like, “Claims 1 rejected [sic] under 35 U.S.C. 102(b) as being anticipated by Hartwig [US 3,668,858].” Clearly this indicates that claim 1 is rejected under 35 U.S.C. 102(b). In the Office Action, claims 1, 3-7, and 14-15 are explicitly rejected for various reasons. Claims 8-9, 11, 13, 16-19 are only mentioned using the “regarding claims” language.

[0202] Applicant will interpret the “regarding claims” language to indicate that those claims are being rejected under the same statute as the preceding explicitly rejected claim. Also, as noted above, claim 12 is not mentioned in the Detailed Action section, so applicant cannot determine the grounds for the rejection of claim 12. However, the arguments below for why the rejected claims should be allowed also apply to any possible reason for rejecting claim 12.

[0203] I. 35 USC § 112, Second Paragraph Rejection

[0204] Claim 1 has been amended to clarify which drive wheel is being described in subsection (d). The specification, including the drawings clearly show that in each embodiment, each drive wheel drives only one indicator. The correction is grammatical in nature and does not introduce new material into the application. The descriptor “first” was implied by the next section’s (section (e)) use of the term “second” to describe the second drive wheel. Therefore, adding the term “first” simply corrects a grammatical omission and does not introduce new material. Section (e) of claim 1 has been amended by the insertion of “said” before “second drive wheel. Although it is clear which drive wheel is being referred to in section (e) and the addition of “said” is not necessary, applicant added “said” to make the language and style more consistent with the other claims.

[0205] Claims 3-7 were also rejected under 35 USC § 112, second paragraph. Applicant presumes that the rejection of claims 3-7 under 35 USC § 112, second paragraph were based on the language of claim 1 and that the correcting of claim 1 also corrects claims 3-7.

[0206] Claim 9 had the same language regarding the first drive wheel as claim 1, yet it was not rejected under 35 USC § 112, second paragraph. However, applicant has modified claim 9 in the same manner as claim 1 to clarify the language.

[0207] II. 35 USC § 102 Rejection: Novelty

[0208] Claim 1 was explicitly rejected in the Detailed Action section of the Office Action. Claims 3, 5, 7-9, 11, 13, and 16-19 are mentioned using the “Regarding claims” language discussed in paragraphs 0201 and 0202. Applicant will treat claims 1, 3, 5, 7-9, 11, 13, and 16-19 as being rejected under § 102 as being anticipated by Hartwig [US 3,668,858].

[0209] For a 35 USC § 102(b) rejection to be appropriate, “the reference must teach every aspect of the claimed invention either explicitly or impliedly.” MPEP 706.02, page 700-21. There are several aspects of applicants claimed invention that are not taught by Hartwig making a § 102(b) rejection inappropriate.

[0210] Applicant's independent claims (claims 1, 8, and 9) all feature a clockwork with two coaxial output shafts, each of which has a drive wheel attached to it. The clockwork shafts are driven by the clockwork. A clockwork, by definition, is a mechanism used to drive a clock. Therefore, applicant's claimed invention uses a clockwork with two coaxial driven shafts, driven at different angular rates, to drive two drive wheel which in turn rotate rigid indicator members.

[0211] A close examination of Hartwig reveals no clockwork with coaxial output shafts, no coaxial output shafts, no drive shafts, and no rigid members hanging on drive wheels. In fact, Hartwig is a radically different design for indicating time than applicant's invention. It is therefore inappropriate to use Hartwig for a § 102(b) rejection (or even a §103 rejection) because every aspect of applicant's invention is not disclosed by Hartwig.

[0212] A close examination of Hartwig further reveals that the entire mechanism is driven by a reciprocating member [38, figures 7 and 16] which carries a disk [29] through 6° by engaging the toothed edge of the disk. This motion is described in detail [column 4, lines 55-58]. The detailed action describes Hartwig as having three output shafts [page 3]. This is incorrect. Hartwig has no output shafts. Hartwig contains a pin [54, column 4, line 34], not a shaft, around which the indicating members rotate. Hartwig is a device which is driven by a single reciprocating arm [38] engaging the edge of a disk used to indicate seconds [29]. Once every minute, the seconds indicating disk [29] rotates so that a special, deeper tooth [37] is presented to the reciprocating member [38]. When the reciprocating member [38] engages the seconds indicating disk [29] at the deeper tooth [37], the deeper penetration of the reciprocating member [38] allows it to also engage a minute indicating disk [17], the result being the both the seconds indicating disk [29] and the minute indicating disk [17] are rotated through 6°. There is also a mechanism, located in the center of the minute indicating disk which rotates the hour indicating disk [44] through a toothed wheel arrangement [figure 2].

[0213] From the preceding paragraph, it can be seen that Hartwig is a radically different design concept than applicant's invention and does not teach every aspect of applicant's claimed invention. Hartwig contains no clockwork with two coaxial output shafts driven at different angular rates. Hartwig does not contain drive wheels. Hartwig contains no rigid members

directly driven by drive wheels. The Detailed Action section of the Office Action inaccurately describes the components and operation of Hartwig. Page 2 of the Office Action reads “Hartwig discloses ... at least two coaxial output shafts [figure 12] driven at different annular [sic] rates [column 3, line 58 – column 4, line 29]...” A close examination of Hartwig [column 3, line 58 – column 4, line 29] reveals that nowhere in that section are “at least tow coaxial output shafts” described or mentioned. Since the true configuration of Hartwig is radically different than applicant’s claimed invention, it is inappropriate to use Hartwig to support a 35 USC § 102(b) rejection.

[0214] III. 35 USC § 103(a) Rejection: Obviousness

[0215] Claim 4 was explicitly rejected in the Detailed Action section of the Office Action under the section titled “Claim Rejections – 35 USC § 103.” Claim 9 is then mentioned using the “Regarding claims” language discussed in paragraphs 0201 and 0202. Applicant will treat claims 4 and 9 as being rejected under § 103(a) as being unpatentable over Hartwig.

[0216] Applicant first notes that the rejection of claim 9 on page 4 of the Office Action describes “rigid members being substantially clear rings and a stationary third member.” Applicant’s claim 4 possesses these characteristics and is discussed in detail starting in the next paragraph. However, applicant’s claim 9 does not claim clear rings or a stationary third member. Applicant asserts that it is inappropriate to make a 103(a) rejection on a claim that certain features are obvious when the claim does not contain those features.

[0217] Applicant’s claim 4 is dependent on applicant’s claim 1. As shown above, applicant’s claim 1 should not have been rejected under 35 USC § 102(b). Applicant notes that the use of clear parts with indicators for hours, minutes and seconds was not contained in any independent claim in his original application. All of the claims containing references to clear parts are dependent claims. By being a dependent claim, claim 4 incorporates claim 1. As discussed above, applicant’s claimed invention in claim 1 is nonobvious with respect to Hartwig. Therefore, the addition of clear elements to applicant’s independently patentable claim 1, should not result in a §103 rejection. Applicant’s addition of clear members to his independent claims

in his dependent claims does not allow applicant's invention to be rejected as obvious in light of the clearness disclosed in Hartwig. In other words, Hartwig has not patented clearness and applicant does not claim that clearness is essential to show novelty and nonobviousness. Applicant asserts that his independent claims are patentable and therefore, derivative versions of applicant's claimed invention that contain clear and/or stationary components are also patentable.

[0218] Claims 6, 14, and 15 were explicitly rejected in the Detailed Action section of the Office Action under the section titled "Claim Rejections – 35 USC § 103" as being unpatentable over Hartwig in view of Truini [US 5,359,578]. The next line of the Office Action states "Hartwig discloses everything claimed except the first rigid member having a smaller diameter than the second rigid member." Page 4. Applicant believes that this statement is factually incorrect. As discussed above, Hartwig is a radically different design than applicant's claimed invention and the Office Action contains factual errors regarding the configuration of Hartwig. Hartwig uses a reciprocating actuator [38] acting on a toothed outer edge to drive the timing components rotating about a fixed shaft [54]. Since Hartwig does not disclose "everything claimed" it is inappropriate to combine Hartwig with Truini's different diameter components and use the combination to reject applicant's claimed invention for obviousness.

[0219] Both the Hartwig and Truini references are complete on their own, so there is no reason to combine them or use features from one and apply them to the other. The combination is also inappropriate because the addition of different sized components from Truini is not a significant part of applicant's invention. Applicant in no way relies on different sized components for his invention to be patentable.

[0220] Page 5 of the Office Action states "It would have been obvious to one of ordinary skill in the art at the time the invention was made to use rings with different diameters for the purpose of improving accuracy." Applicant never claimed that rings of different diameters improve accuracy. Since applicant never claimed this, it seems both immaterial whether or not the different diameters improve accuracy and unlikely that different diameter rings would improve accuracy. Also, the statement is meant to summarize the rejection of claims 6, 14, and 15, but claim 15 mentions a disk and a ring, not "rings with different diameters." Applicant

asserts that since Hartwig does not disclose “everything claimed except the first rigid member having a smaller diameter than the second rigid member,” (Office Action page 4), it is incorrect to combine Hartwig with Truini’s feature of components with different diameters and arrive at a §103(a) rejection of claims 6, 14, and 15. The combination of Hartwig and Truini simply does not disclose “everything claimed.”

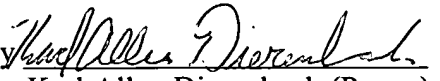
[0221] IV. Summary

[0222] Given the mechanical novelty and nonobviousness of applicant’s design, applicant’s invention represents a novel and nonobvious improvement over the prior art. Applicant has clearly demonstrated how Hartwig is an inappropriate reference for both the 35 USC § 102(b) rejection and the 35 USC § 103(a) rejection. Accordingly, applicant respectfully requests that a timely Notice of Allowance be issued in this case.

[0223] Applicant wishes to express concern over the direction of this patent application. Applicant originally received an Office Action dated March 31, 2004. After a detailed phone conversation with Michael L. Lindinger, the examiner assigned to the application, applicant submitted an extensive and detailed amendment on August 25, 2003. That amendment put forth changes and arguments to overcome the then-current rejection. Since none of those issues have been acknowledged, revisited, or mentioned in the current Office Action, applicant assumes that the original Office Action rejections have been overcome. The current office action uses patents known at the time of the first Office Action (in fact, Hartwig was discussed in the Office Action and amendment) to assert rejections on completely new grounds. It is applicant’s understanding that the PTO attempts to present Office Actions in such a manner that overcoming the rejections in the Office Action will result in issuance of a patent. To overcome rejections, only to be faced with another round of rejections based on different prior art, different reasoning, and different statutes, seems to be non-ideal.

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Respectfully submitted,

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